

REMARKS

This application has been reviewed in light of the Office Action dated May 20, 2005. Claims 23-46 are now presented for examination, of which Claims 23, 34, 45, and 46 are in independent form. Favorable reconsideration is requested.

Claims 7, 8, 16, 17, 20, and 22 were rejected under 35 U.S.C. § 102(b) as being anticipated by WIPO Publication No. WO 99/14909 (Chalmers et al.); and Claims 1-6, 9-15, 18, 19, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chalmers et al., in view of U.S. Patent No. 6,073,142 (*Geiger et al.*).

Applicant submits that independent claims 23, 34, 45, and 46, together with the remaining claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

Claims 23 is directed to a communication apparatus including a receiving unit adapted to receive an E-mail stored in a mail box provided on an E-mail server, and a first obtaining unit adapted to obtain attribute information of the E-mail stored in the mail box. A discriminating unit discriminates whether or not to receive the E-mail based on the obtained attribute information. A controlling unit is adapted to, in a case where the discriminating unit discriminated not to receive the E-mail, send to the E-mail server an instruction for deleting from the mail box the E-mail that the discriminating unit discriminated not to receive.

Notably, in Claim 23, the reception operation for the E-mail that the communication apparatus at the reception side discriminated not to receive is not performed again. By virtue of the features of Claim 23, (1) the throughput of the E-mail reception operation by the communication apparatus can be improved, and (2) it is possible

to prevent an E-mail, not received by the communication apparatus at the reception side, from remaining in the E-mail server indefinitely, whereby the load to the E-mail server can be decreased.

Chalmers et al., as understood by Applicant, relates to a messaging system by which an E-mail received from the transmission side is transferred to each intended destination by the transmission-side apparatus. In the relevant messaging system, the size of the E-mail is obtained, and a part of the received E-mail message is extracted by the message filter 2 (see Fig. 2) when the obtained size exceeds the threshold (see Steps 304 and 340 of Fig. 3, and Steps 411 and 440 of Fig. 4). Moreover, Chalmers et al. discusses that, when the part of the E-mail message is extracted, its reference data is transferred to each intended destination (see Step 342 of Fig. 3, and Step 450 of Fig. 4).

Geiger et al., as understood by Applicant, relates to a system in which an E-mail is transferred, deleted, and returned based on the business rule at the gatekeeper of the automatic E-mail system. More specifically, as shown in Fig. 4A of Geiger et al., the E-mail is received from the transmission side (404), the action (determined based on the size of the E-mail, the number of attachments, etc.) to the E-mail message is applied (412), and, in the case of deletion, the E-mail message is deleted (422).

Both Chalmers et al. and Geiger et al. relate to the construction of a conventional E-mail server which transmits an E-mail to a communication device. The E-mail servers of Chalmers et al. and Geiger et al. do not transmit and transfer the E-mail to the destination intended by the transmission-side apparatus (that is, to the communication apparatus at the reception side) in a case where, for example, the size of the E-mail received from the transmission side exceeds a predetermined value. That is, the

E-mail servers disclosed in Chalmers et al. and Geiger et al. act as conventional E-mail servers.

As noted above, Chalmers et al. (see Fig. 2) discusses that a part of the received E-mail message is extracted by the message filter (2 of Fig. 2) when the size of the received E-mail exceeds the threshold. However, the header and the attachment 24 are received and stored in the store 6; that is, they are not deleted.

Meanwhile, Geiger et al. discusses that, with respect to an E-mail discriminated not to be transmitted and transferred to the communication apparatus at the reception side, the E-mail is once received from the transmission side, and then the received E-mail is deleted at the own terminal. It follows that the E-mail is deleted at the E-mail server. An E-mail to be received by the communication apparatus at the reception side is not deleted and is not instructed to be deleted, the communication apparatus at the reception side being the destination intended by the transmission side.

Applicant submits that any hypothetical combination of Chalmers et al. and Geiger et al., even assuming such to be permissible, would result in an E-mail server of a communication apparatus at the reception side which suffers from the inconvenience that, although the communication apparatus discriminated not to receive the relevant E-mail, the E-mail has to be received once and then deleted in the communication apparatus on the reception side.

Moreover, in that hypothetical combination, any deletion would not be instructed to the transmission side which transmits the E-mail that the reception side discriminated not to receive, whereby the E-mail that the reception side discriminated not to receive would not be deleted on the transmission side. That is, the same E-mail would

be redundantly received from the transmission side and then deleted, with the result being that the unnecessary reception operation is repeated. Furthermore, the relevant E-mail would not be deleted in the E-mail server at the transmission side, and would remain in the mail box of the E-mail server at the transmission side indefinitely.

On the other hand, according to Claim 1, with respect to an E-mail which was applied to the reception-side communication apparatus but discriminated not to be received, the deletion is instructed from the relevant reception-side communication apparatus to the E-mail server at the transmission side. Thus, by virtue of the features of Claim 1, it becomes unnecessary for the communication apparatus at the reception side to perform the reception operation for the relevant E-mail transmitted from the E-mail server at the transmission side. Moreover, in Claim 1, an E-mail that the reception-side communication apparatus, being the destination intended by the transmission side, discriminated not to receive is deleted from the E-mail server at the transmission side, and by virtue of this the load to the E-mail server can be decreased.

Nothing in Chalmers et al. or Geiger et al., whether considered separately or in any permissible combination (if any) would teach or suggest discriminating whether or not to receive an E-mail stored in a mail box provided on an E-mail server, based on obtained attribute information of the E-mail stored in the mail box, and when it is discriminated not to receive the E-mail, sending to the E-mail server an instruction for deleting from the mail box the E-mail that it was discriminated not to receive, as recited in Claim 1.

Accordingly, Claim 1 is believed to be patentable over Chalmers et al. and Geiger et al., whether considered either separately or in any permissible combination (if

any).

Independent Claims 34, 45, and 46 each recite features similar in many relevant respects to those discussed above with respect to Claim 1 and therefore are also believed to be patentable over Chalmers et al. and Geiger et al., whether considered either separately or in any permissible combination (if any), for the reasons discussed above.

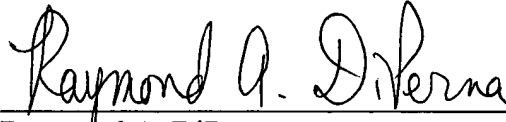
A review of the other art of record has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, reading "Raymond A. DiPerna". The signature is written in a cursive style with a horizontal line underneath it.

Raymond A. DiPerna
Attorney for Applicant
Registration No.: 44,063

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200

NY_MAIN 515656v1